

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/747,063
Attorney Docket No.: A8063

REMARKS

Claims 1-42, 46-48, 51, 52 and 54-60 are all the claims pending in the application. By this Amendment, Applicant amends claims 12, 55, and 57 to further clarify the claimed invention.

Summary of the Office Action

The Examiner withdrew the previous rejections and issued new rejections. Specifically, the Examiner rejected claims 52, 53, and 57 under 35 U.S.C. § 112, first paragraph and claims 1-42, 46-48, 51, 52, and 54-60 under 35 U.S.C. § 103.

Claim Rejections under 35 U.S.C. § 112

Claims 52, 53, and 57 are rejected under 35 U.S.C. § 112, first paragraph. Applicant respectfully traverses these grounds for a rejection in view of the following comments.

It is respectfully noted that claim 53 is not pending in the application and has been previously canceled. Accordingly, this rejection with respect to claim 53 is moot.

With respect to claim 52, the Examiner maintains that the specification does not disclose or suggest “at least two of said plurality of applets do not inherit functions from same base class” (*see page 2 of Office Action*). It is respectfully noted that the specification provides ample support for the above-noted features of claim 52. For example, the specification discloses that the invention works in conjunction with the IBM Enterprise Information Portal. “The intent is to bring together various applets to be used on what are called a “Portal” webpages (Fig. 6, page 6, line 19 to page 7, line 3 of the specification). That is, in an exemplary, non-limiting embodiment, various independent applets can be loaded and displayed within the main applet. One of ordinary skill in the art would readily understand that when one applet is independent

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from another, it does not inherit functions of the same base class. Otherwise, the applets are considered dependent. In other words, it is Applicant's position that the specification provides adequate support for the unique features of claim 52.

With respect to claim 57, the Examiner contends that the specification does not support "only names and attributes of the plurality of applets are displayed in the displayed main applet, where the plurality of applets are not yet loaded for execution" (*see* page 3 of the Office Action). It is respectfully noted, however, that an exemplary embodiment of the present invention discloses generating a list of available applets in block 210. Thereafter, the WebTop applet displays the list of available applets, in block 230. The user then selects one or more applets in block 240 and in block 260, the selected applets are executed (Fig. 2, page 10, line 17 to page 11, line 9 of the specification). In other words, the plurality of available applets are displayed. Once the applet is selected, it is loaded for execution *e.g.*, Fig. 3. In other words, the specification provides ample support for displaying a list of available applets and selecting applets for loading and execution. To further prosecution of the above-identified application, "only names and attributes" have been deleted from claim 57.

In view of the foregoing, Applicant respectfully requests the Examiner to withdraw this rejection of claims 52 and 57.

Prior Art Rejections

Claims 1-4, 9-12, 14-18, 23-26, 28-32, 37-40, 42, 46-48, 51-58, and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/43170 to Banthia (hereinafter "Banthia"). Applicant respectfully traverses these grounds for a rejection in view of the following comments.

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A. Legal Standard

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rikckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; see also, *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

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In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

B. *Claimed Invention*

Independent claims 1, 15, 29, 46, and 57 recite *inter alia* that the main applet is displayed and each selected applet is displayed in the separate window inside the displayed main applet.

For example, in an illustrative, non-limiting embodiment, a WebTop is a dynamic environment in which any applet can run (¶¶ 37 and 46-48 of the specification). The WebTop is a main applet that allows other applets to run inside of it, and is not related to providing any direct applet to applet communication environment. Each applet added to the WebTop, from various servers or other machines, runs inside its own window that can be moved, resized, minimized or closed. The WebTop has a menu of applets that are available to run and the ability to scan other web pages and add any found applets to the repository of available applets, (¶¶ 55-62 of the specification). It will be appreciated that the foregoing remarks relate to the application in a general sense, the remarks are not limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claims mentioned above.

C. *Prior Art Reference*

Banthia, on the other hand, relates to improving communication between applets by optimizing the number of connections to the server (*see Abstract*). Specifically, Banthia discloses that a client is connected to a particular Web server (page 5, lines 19 to 22) and a

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controlling applet provides data to a set of display applets (page 5, lines 23 to 25). In Banthia, the controlling applet is a hidden applet, which is not displayed (page 5, lines 33 to 35). The controlling applet in Banthia has the height and width parameter of zero (page 8, lines 23 to 24). The controlling applet is an active applet, which means that it establishes a connection to the server. The set of display applets are passive applets, which means that they do not establish a connection to the server. Even though the passive applets do not have a connection to the server, their information is continually updated by the controlling applet (page 6, lines 2 to 9). In Banthia, the display applets are displayed within a single browser window (page 8, lines 19 to 21).

D. *Examiner's Position*

The Examiner withdrew the rejection of claims 1, 15, 29, 46, and 57 under 35 U.S.C. § 102 as being anticipated by Banthia. That is, as agreed by the Examiner in a telephonic interview on March 27, 2006, Banthia does not disclose at least the above-noted unique features of the independent claims.

The Examiner, however, contends that Banthia suggests these features. Specifically, the Examiner's position is provided on page 4 of the Office Action and is quoted below:

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(page 7, 1-7). Banthia clearly discloses that a main applet exists but does not disclose that a window is displayed for the applet. Banthia discloses the existence of a main applet, which is responsible for displaying a list of applets, but does not disclose that the main applet is displayed. It would have been obvious for one skilled in the art at the time of the invention to disclose that the main applet is displayed. Banthia discloses a main applet and further provides parameters that have been set to ensure that the main applet is not displayed (page 8, lines 20-25). But one skilled in the art could change the parameters to display the main applet. Hence, it would have been obvious to one skilled in the art at the time of the invention to display the main applet.

In other words, the Examiner contends that one of ordinary skill in the art could change the parameters to display the control applet (alleged main applet).

E. Applicant's Position

It is Applicant's position that the USPTO failed to satisfy the first and third requirements in establishing a *prima facie* case of obvious.

To begin, there is no motivation for modifying the disclosure of Banthia so as to display the control applet. The USPTO has not set forth *any motivation* for modifying Banthia so as to display the control applet. In fact, the control applet is a communication applet *i.e.*, a bridge between the displayed applets and the server (*see Abstract*). In other words, the control applet provides data to the displayed applet (page 5, lines 1 to 33 of the specification). One of ordinary skill in the art would not have and could not have been motivated to display a control applet.

As acknowledged by the Examiner, Banthia does not disclose displaying selected applets within the main applet. The Examiner, however, alleges that one of ordinary skill in the art could change the parameters to display the control applet (alleged main applet). However, as

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indicated in the MPEP § 2143.01.III, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” That is, the fact that allegedly the height and width parameters of the control applet may or can be changed from zero does not render the claimed invention obvious over Banthia. In fact, Banthia clearly *teaches away* from displaying the control applet (*i.e.*, control applet is hidden, the display size is zero and etc).

Accordingly, it is Applicant’s position that the USPTO did not meet the first requirement in establishing a *prima facie* case of obviousness.

Furthermore, the USPTO did not meet the third requirement in establishing a *prima facie* case of obviousness. That is, Banthia does not disclose or suggest “each selected applet is displayed in the separate window inside the displayed main applet.” That is, even assuming *arguendo* that Banthia somehow suggests displaying the control applet. Banthia does not even remotely suggest displaying the display applets within the displayed control applet. In short, Banthia does not disclose or suggest each selected applet being displayed in the separate window inside the displayed main applet.

E. Concluding Remarks

For at least these exemplary reasons, independent claims 1, 15, 29, 46, and 57 are patentable over Banthia. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of independent claims 1, 15, 29, 46, and 57, and the other rejected claims which depend therefrom.

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Furthermore, independent claim 57 recites: “dynamically selecting a plurality of applets from a displayed list of the plurality of available applets that are displayed in the displayed main applet, where the plurality of applets displayed in the list are not yet loaded for execution.” The Examiner alleges that the six applets displayed in a browser window as depicted in Fig. 5 of Banthia meet the unique features quoted above because each applet is executed and displayed together with its name (*see* page 8 of the Office Action).

Applicant respectfully submits, however, that Banthia fails to disclose or suggest displaying a list of the unloaded available applets *i.e.*, a list of available applets prior to the applets being loaded. That is, Banthia only discloses providing the name of the applet during its execution (Fig. 5). In other words, Banthia does not disclose or suggest providing a list of available applets not yet loaded or executed. For at least this additional exemplary reason, independent claim 57 is patentable over Banthia.

F. Additional Arguments for Dependent Claims

Dependent claim 12 further recites: “executing the main applet to display, within the displayed main applet, a list of available applets from which users can select applets.” The Examiner contends that Fig. 5 and page 5, lines 23 to 32 of Banthia disclose these unique features of claim 12 (*see* page 5 of the Office Action). Applicant respectfully submits, however, that the portion of Banthia cited by the Examiner only discloses inheritance and providing data to the displayed applets via the control applet. In other words, in the cited portion of Banthia as well as in other portions of Banthia reference, there is no disclosure or even remote suggestion of having a list of available applets being displayed within the main applet from which users can

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select applets. For at least these additional exemplary reasons, claim 12 is patentable over Banthia.

Dependent claim 52 recites: “said plurality of applets are independent of each other and at least two of said plurality of applets do not inherit functions from same base class.” The Examiner alleges that Banthia discloses that each applet inherits from a different base class (*see* page 7 of the Office Action). Clearly, Fig. 3 of Banthia does not suggest that each applet inherits from a different base class. Banthia only discloses that the display applets inherit from the same base class (*see* page 7, lines 24 to 34 of Banthia). Furthermore, in Banthia, same model is displayed in multiple views (applets) *i.e.*, one applet is provided for each view (Fig. 5). That is, in Banthia, the displayed applets are interdependent. The displayed applets all depend from the same base class *i.e.*, inherit features of the same base class (Fig. 3; page 7, lines 24 to 34 of Banthia). In short, Banthia fails to suggest displaying *any type* of applets *i.e.*, applets that do not inherit functions from the same base class. For at least this additional exemplary reason, claim 52 is patentable over Banthia.

Dependent claim 60 recites: “at least two applets of said applets are obtained from different computers and are displayed in a respective window inside the displayed main applet at same time.” The Examiner alleges that since applets are accessed from a server by client computer, this allegedly discloses the applets being from different computers (*see* page 10 of the Office Action). Applicant respectfully disagrees.

In Banthia, all applets are displayed and the communication with the server is optimized by having one communication applet (the control applet) handling the communication for all these applets (page 6 of Banthia). In other words, all applets being displayed are handled via one

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communication threat and accordingly, is obtained from same place. In Banthia, there is no suggestion that the applets are obtained from different computers. The Office Action did not substantiate the allegation that Banthia discloses obtaining applets from different computer with specific citations from the Banthia reference. For at least this additional exemplary reason, claim 60 is patentable over Banthia.

G. *Rejections in view of Banthia, Southgate, and STS*

Claims 5-8, 19-22, 33-36 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia in view of U.S. Patent No. 5,561,757 to Southgate (hereinafter “Southgate”) and claims 13, 27, and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Banthia and “The Swing Tool Set” article (hereinafter “STS”). Applicant respectfully traverses these grounds for a rejection in view of the following comments.

It is respectfully submitted that Southgate and the STS reference fail to cure the deficiencies of Banthia discussed above for claims 1, 15, and 29, and accordingly, claims 5-8, 13, 19-22, 27, 33-36, and 41 are patentable over the asserted combination, of Banthia and Southgate and Banthia and the STS reference, at least by virtue of their dependency from the independent claims discussed above.

In addition, it is respectfully submitted that one of ordinary skill in the art would not have and could not have combined Banthia with STS. The Examiner contends:

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Referring to claims 13, 27 and 41, Banthia does not disclose using a JInternal frame window to represent the applet windows. "The Swing Tool Set" article discloses a means for using JInternal frames, wherein these components would be used to represent objects, such as windows in desktop environments (page 10, row 4), much like the desktop environments of Banthia. It would have been obvious for one skilled in the art, at the time of the invention to learn from the article to implement the window representation of the applets through a JInternal frame component. JInternal frame components are obviously used to represent objects within a desktop environment, much like the ones used in Banthia. Hence, it would have been obvious for one skilled in the art, at the time of the invention to learn from the article to implement the applets such as they are represented through JInternal frame windows.

From the tenor of the grounds of rejection quoted above, it would appear that, even though no anticipatory or particularly relevant reference has been found, the present invention is too simple to be deserving of a patent. As a result, the formulated grounds of rejection, at first blush, appear to be based on actual prior art disclosure, but instead are based on a hindsight rationale that anyone aware of JInternal frame component, in theory, could have implemented them to generate separate windows for the applets.

That is, the STS only discloses "JInternalFrame implements a frame object that can be placed inside a JDesktopPane object to emulate a native frame window." That is, as in conventional techniques, the STS discloses using JInternalFrame for holding a document. However, JInternalFrame are not intended for applet visibility. JInternalFrame lacks operations for holding an applet (*see e.g.*, page 9 of the specification). In other words, there is no suggestion in the STS to implement the JInternalFrame for the applets. Furthermore, the Examiner has not set forth *any* motivation why one of ordinary skill in the art would use

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JInternalFrame to display applets as opposed to IFRAME or HTML frame (*see e.g.*, pages 2-4 of the specification).

Accordingly, there are several reasons why, on the present record, the USPTO can, and indeed must, grant such a patent. First, as noted in MPEP § 2141, “Office policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. § 103.” Grounds of rejection based on a rationale such as the one just described distort each of the Graham factual inquiries, and produce a distorted determination as a result. Since the rationale is not rooted in actual prior art, productive discussion regarding the true scope and content of the prior art is no longer feasible. This, in turn, renders it impossible to clearly ascertain the actual differences between the prior art and the claims at issue. Also, since the rationale is a purely hypothetical construct, it is by its very nature a creature of hindsight, which makes any advance over the art appear trivial.

Second, it is immaterial whether or not the invention is simple. “Simplicity is not inimical to patentability.” In re Oetiker 24 USPQ2d 1443, 1446 (Fed. Cir. 1992)(citations omitted). Simplicity alone is an improper standard under which to assess obviousness and, in turn, patentability. The Graham factual inquiries alone are used for assessing patentability.

In other words, it is Applicant’s position that the USPTO did not provide *any* motivation for combining the STS with Banthia. Furthermore, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine Banthia with STS without exercising impermissible hindsight.

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Statement of Substance of Interview

The interview was administrative in nature. That is, Applicant called the Examiner because the Office Action issued July 17, 2006 did not set a shorter period for a response. Accordingly, the Examiner sent out a new Office Action that set the shortened period for a response. No claims and no prior art references were discussed during the Interview.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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